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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,879	09/08/2000	Toshihiko Oda	S0255.0004/P004	2562
24998	7590	08/21/2006	EXAMINER	
DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403			PRIETO, BEATRIZ	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 08/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/658,879

Applicant(s)

ODA, TOSHIHIKO

Examiner

Prieto Beatriz

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-6, 9-12, 15-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-6, 9-12 and 15-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***DETAILED ACTION***

1. This communication is in response to Request for Amendment filed 05/15/06, claims 3-6, 9-12 and 15-28 remain pending and hereby are set forth for examination.
2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). Certified copy has been received of Application No. 11-255097, filed on 09/09/99 in Japan.
3. Claim interpretation, the claimed terms functions, refers to features, capabilities or functions associated with (devices) printers. According applicant's disclosure a "profile of an ideal virtual device" seems to refer to all the capabilities of the devices collectively, i.e. "integrated" (see specs p. 11, lines 3 to page 17). The broadest reasonable interpretation will be given to the claim limitation in light of the specification (see MPEP § 2111).
4. Claim 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case, claim 28 is object to because "the selected functions" seem to lack antecedent basis, thus it is not clear what selected functions does this clause refer to.

***Claim Rejections - 35 USC § 103***

5. Quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.
6. Claims 3-6, 9-12 and 15-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roy et. al (US 6,496,859) (Roy hereafter) in view of Shimizu et. al. (US 6,609,162) (Shimizu hereafter).

Regarding claim 19, Roy teaches a system/method usable for selecting a device from a number of devices connected to a network, said apparatus comprising:

a detecting unit (10) which detects all the devices (35) connected to the network (45) (col 3/lines 27-37);

an extracting unit (10) which extracts information ("profiles") from the devices information (65) relating to identity of each said device (col 2/lines 31-38, 52-57, extract information: col 4/lines 3-12, data (65): col 3/lines 51-59 and col 5/lines 35-37);

an integrated profile creating unit (10) which creates a collection ("integrated profile") of information obtained by combining or adding the information ("profiles") of said devices (Roy: collection or adding information from and about all located devices: col 5/lines 42-col 6/line 9); although prior art teach creating a table containing a listing of said devices used by the user for selecting a device from among said devices, prior art does not teach where the table contains information about the functions available by the device e.g. for the use of each device,

Shimizu teaches a system/method related to the selection of network devices by a user (see abstract) including, in a network connecting a plurality of devices, the image processing function of each device, information for specifying each device, and the like are collected (abstract);

gathering function information indicating a function of each of the plurality of devices from each of the plurality of devices (col 2/lines 5-9, Fig. 5-7, col 13/lines 49-52), including combining the function information of each of the plurality of devices on the network (col 6/lines 17-23); all functions which can be obtained for each device on the network are obtained (col 13/lines 63-67);

storing function information indicating the functions of each of the plurality of devices from each of the plurality of devices (col 9/lines 14-21);

the function information indicating performances and features of each device (col 6/lines 25-27, col 5/line 18-25) is collected and stored (col 5/line 65 to col 6/line 16);

It would have been obvious to one ordinary skilled in the art at the time the invention was made given Roy's suggestion of discovering profiles comprising information relating to the functions of multiple devices having multiple categories, to utilize Shimizu's teachings for enabling a user select viewable all usable functions obtained from the plurality of devices on

the network, because in doing so it enables a user to easily set a desired function as if a single device is used and to improve the operability of devices, furthermore since all function which can be obtained on the network are automatically determined and displayed, the use can use the system without being aware of the combination of devices, as suggested by Shimizu.

Regarding claim 3, a user interface created by said user interface creating unit which displays information relating to the functions comprising the integrated profile for a user's selection ("with respect to a user") on a display screen (Roy: Fig. 7) and enables the user to select necessary categories of functions from the categories of functions displayed on said display screen (Shimizu: selecting a desired function from among a category of functions col 13/lines 11-47).

Regarding claim 4, a memory unit which stores the profiles extracted by said extracting unit (Roy: data structure to store device information: col 3/lines 5-59), wherein when said selecting unit has used ("consulted") the stored profiles and determined that there is no device comprising all the categories which have been selected via the user interface, said selecting unit selects said device from among said devices which comprises a part "subset" of the selected categories (i.e. given the stored profiles (device information), the categories (device function or capabilities) selected by the user and a predetermined priority, if no device comprises all the categories the device satisfying as much desirable conditions as possible is selected (Roy, col 5/lines 18-25).

Regarding claim 5, when a new category "reselects" has been selected via said user interface after said device has been selected, said selecting unit reselects said device by including the category which has been selected this time by priority in said part of the categories (i.e. selection of categories by priority enable the selection of device that satisfies selected category (or new category) when the device contains that is satisfies all required categories selected by the user according to a specified priority, e.g. priority B, wherein conditions that should preferable (most of or in part of the categories) (Shimizu: col 13/lines 15-34).

Regarding claim 6, wherein said devices are printers 35 (Roy: abstract, col 3/lines 27-37).

Regarding claims 9-12, these claims are substantially the same as claims 3-6, respectively, same rationale of rejection is applicable.

Regarding claims 15-18, these claims comprises the apparatus or software implementation, i.e. computer readable medium for storing instructions, which when executed by a computer, causes the computer to perform the functions discussed on apparatus claims 3-6, respectively, same rationale of rejection is applicable to the computer product claims.

Regarding claim 20, a user interface creating unit which (i.e. a browser or web enable PC) which creates a user interface enabling functions (called “necessary functions”) to be selected from the functions on the integrated profile created by the integrated profile creating unit (Roy: col 1/lines 15-23 and Shimizu: col 13/lines 49-col 14/line 3).

Regarding claim 21, creating a table related to a priority order of said devices in which the devices have a preference base on predetermined criteria, i.e. are “preferably used” (Roy: a device having the highest final score is selected “selecting unit” as an optimum device printer from among the printers using a criterion, col 6/lines 66-col 7/line 11).

Regarding claims 22-23, this claim is substantially the same as claims 19 and 3, respectively, as discussed above, same rationale of rejection is applicable.

Regarding claim 24, substantially the same as claim 21 as discussed above, same rationale of rejection is applicable.

Regarding claims 25-26, these claims comprise the computer readable medium storing the executable instructions associated with the method and apparatus discussed on claims 19-21, same rationale of rejection is applicable.

Regarding claim 28, the combined teachings of Roy and Shimizu teach

a detecting unit (10) which detects all the devices (35) connected to the network (45) (Roy: col 3/lines 27-37);

an extracting unit (10) which extracts information ("profiles") from the devices information (65) relating to identity of each said device (Roy: col 2/lines 31-38, 52-57, extract information: col 4/lines 3-12, data (65): col 3/lines 51-59 and col 5/lines 35-37);

an integrated profile creating unit (10) which creates a collection ("integrated profile") of information obtained by combining or adding the information ("profiles") of said devices (Roy: collection or adding information from and about all located devices: col 5/lines 42-col 6/line 9);

a data structure "table" contains information about the functions available by the device e.g. for the use of each device by gathering function information indicating a function of each of the plurality of devices from each of the plurality of devices (Shimizu: col 2/lines 5-9, Fig. 5-7, col 13/lines 49-52),

the table comprises combined the function information of each of the plurality of devices on the network (Shimizu: col 6/lines 17-23) and all functions which can be obtained for each device on the network are obtained (Shimizu: col 13/lines 63-67);

the table comprising stored function information indicating the functions of each of the plurality of devices from each of the plurality of devices (Shimizu: col 9/lines 14-21) and the function information indicating performances and features of each device (Shimizu: col 6/lines 25-27, col 5/line 18-25) is collected and stored (Shimizu: col 5/line 65 to col 6/line 16);

the table related to an arrangement or order "priority order" of the devices (column 4, lines 14-25, Fig. 7, and column 6, lines 1-9; Shimizu creating an arrangement for use of the device, such as location, or class of device, see column 6, lines 62-67); order comprises a priority in the order of the a printer having the highest speed, a printer having the second highest speed color printer and

selecting based on the selected function and the table (Shimizu: column 13, lines 27-34)

### *Response to Arguments*

7. Regarding claims 3-6, 9-12 and 15-27 are rejected as being unpatentable over Roy et. al in view of Shimizu et. al., it is argued (p. 1 of remarks) that the office action does not identify where a suggestion to combine the references exist.

In response to the above-mentioned argument applicant's interpretation of the applied prior art has been fully considered. Office action mailed 2/15/06 last paragraph of page 3, indicates It would have been obvious to one ordinary skilled in the art at the time the invention was made given Roy's suggestion of discovering profiles comprising information relating to the functions of multiple devices having multiple categories, to utilize Shimizu's teachings for enabling a user select viewable all usable functions obtained from the plurality of devices on the network, because in doing so it enables a user to easily set a desired function as if a single device is used and to improve the operability of devices, furthermore since all function which can be obtained on the network are automatically determined and displayed, the use can use the system without being aware of the combination of devices, *as suggested by Shimizu*. (see column 4, lines 1-6 and column 1, line 58 to column 2, line 2)

8. Regarding claims 3-6, 9-12 and 15-27 are rejected as being unpatentable over Roy et. al in view of Shimizu et. al., it is argued (p. 2 of remarks) that Roy fails to disclose that an optimum device can be selected by inputting a function which is necessary for a user, because ROY et. al. display only a device list.

In response to the above-mentioned argument, applicant's interpretation of the applied prior art has been carefully reviewed. Claim 20 reads, a unit creating an interface that enables functions to be selected from the functions of the created integrated profile.

Shimizu et. al. teaches collecting the image processing function of each device of a plurality of devices connected to the network, information for specifying each device, and functions realizable by combining two or more devices, where the respective combinations are indicated by *profiles*; each device which has received the profiles displays executable functions based on the profiles, and performs control, such as the operation of the device, transfer of data, and the like, in order to realize *a function selected from among the displayed functions*.



(abstract, see Figs. 18-27); indicating *all functions* realizable by any combination of image input devices and image output devices which are currently connected to a network is formed *based on information (device information) relating to the function of each of the image input devices and image output devices*, it is thereby possible to display on a display picture frame of each of the devices not only the function of that device itself but also *all functions which can be realized by combination with another device on the network*, and the user can use a "virtual device" obtained by combining devices on the network as if it were a single device without being aware of the combination of the devices. At that time, only functions realizable by combining devices are displayed instead of displaying the functions of all other devices. (see column 3, line 55 to column 4, line 5).

Thus, Shimizu teaches displaying functions to be selected from the functions of the created integrated profile of an "ideal virtual device" comprising to all the capabilities/functions of all the devices collectively, i.e. "integrated".

9. Regarding claims 3-6, 9-12 and 15-27 are rejected as being unpatentable over Roy et. al in view of Shimizu et. al., it is argued (p. 3 of remarks) that the applied prior art fails to teach a table related to a priority order of the devices, as recited on new claim 28.

In response to the above-mentioned argument, applicant's interpretation of the applied prior art has been considered. The claimed term "preferred priority" and/or "priority order" has been applied the broadest reasonable interpretation according to the specification, as mandated (see MPEP 2111). According with the invention's disclosure, Fig. 5 shows an integrated profile which is created by collecting from these four profiles the categories which have the highest capabilities. Fig. 6 shows a priority ranking table which is created based on a predetermined reference for determining (e.g. faster in printing, installed nearby, etc.). As shown in Fig. 6, the first printer is the default and is number one in the priority ranking (specs column 16, lines 18-24).

However, Roy teaches creating a structure "table" related to an "order" arrangement of devices, by extracting from all the detected devices connected on the network and storing in a data structure according to an order, e.g. class of devices, device brand, sub-network location (column 4, lines 14-25); Roy teaches displaying a created table specifying an order or

arrangement on Figure 7, illustrates a table specifying an order for use of the devices, the order comprising ordering devices according to a particular model, particular sub-network, or alphabetical name order (column 6, lines 1-9). Roy teaches priority rankings for use of said devices, wherein an output destination printer selection section 11 ("selecting unit"), wherein a device having the highest final score is selected as an optimum device printer from among the printers using a criterion, such as the printer name order, ascending order of the number of printer operation times, identification number order, or preset priority (i.e. "priority ranking") (col 6/lines 66-col 7/line 11).

Shimizu also suggested specifying a arrangement "priority order" for use of the device, such as location, class (column 6, lines 62-67); where all functions which can be realized devices are presented to the user, and the user can use a "virtual device" obtained by combining devices on the network as if it were a single device (see column 3, line 55 to column 4, line 5).

10. Applicant's arguments filed with the above-mentioned amendment has been fully considered but not found persuasive.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:  
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